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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/754,556	01/12/2004	Masakazu Sagawa	ASAM.0095	8215

7590
REED SMITH LLP
Suite 1400
3110 Fairview Park Drive
Falls Church, VA 22042

11/21/2007

EXAMINER

SMITH, NICHOLAS A

ART UNIT	PAPER NUMBER
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1795

MAIL DATE	DELIVERY MODE
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11/21/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/754,556	Applicant(s) SAGAWA ET AL.	
	Examiner Nicholas A. Smith	Art Unit 1795	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/959,953.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7 August 2007 has been entered.

Status of Claims

2. Claims 1-10 remain for examination.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent 08-134692 (JP'692).

5. In regards to claims 1-3, JP'692 discloses a method of anodizing a conductive film laminated on an insulative film by using a non-aqueous electrolyte containing an organic solvent having an alcoholic hydroxyl group and at least one solute selected from salts of inorganic oxo acids and salts of organic carboxylic acids containing not more than 2 alcoholic hydroxyl groups (JP'692, claims 1-4, paragraph [0010]). Regarding to

the preamble of claim 1 of "having a second substrate with a phosphor layer formed on a surface thereof", there is no active step recited in the claim regarding the second substrate. Therefore, the preamble merely states the intended use and would not be given a patentable weight. See MPEP 2111.02.

6. In regards to claim(s) 1, JP'692 discloses a range of amount of water in the electrolyte (claim 3) that overlaps the claimed range and therefore establishes a case of prima facie obviousness. See MPEP 2144.05. It would have been obvious to one of ordinary skill in the art to select the claimed range from the prior art range because the prior art teaches the same utility over the entire range.

7. In regards to claims 4-6, JP'692 discloses a method of anodizing a conductive film laminated on an insulative film by using a non-aqueous electrolyte containing an aprotic organic solvent and at least one solute selected from salts of inorganic oxo acids and salts of organic carboxylic acids containing not more than 2 alcoholic hydroxyl groups (JP'692, claims 1-4, paragraph [0010]). Regarding to the preamble limitation in claim 4, the examiner's position was given in paragraph 5 above.

8. In regards to claim(s) 4, JP'692 discloses a range of amount of water in the electrolyte (claim 3) that overlaps the claimed range and therefore establishes a case of prima facie obviousness. See MPEP 2144.05. It would have been obvious to one of ordinary skill in the art to select the claimed range from the prior art range because the prior art teaches the same utility over the entire range.

9. In regards to claims 7-10, JP'692 discloses a method of anodizing a conductive film laminated on an insulative film by using a non-aqueous electrolyte containing a

mixed solvent comprising an organic solvent having an alcoholic hydroxyl group and an aprotic organic solvent and at least one solute selected from salts of inorganic oxo acids and salts of organic carboxylic acids containing not more than 2 alcoholic hydroxyl groups (JP'692, claims 1-4, paragraph [0010]). Regarding to the preamble limitation in claim 7, the examiner's position was given in paragraph 5 above.

10. In regards to claim(s) 7, JP'692 discloses a range of amount of water in the electrolyte (claim 3) that overlaps the claimed range and therefore establishes a case of prima facie obviousness. See MPEP 2144.05. It would have been obvious to one of ordinary skill in the art to select the claimed range from the prior art range because the prior art teaches the same utility over the entire range.

Response to Arguments

11. Applicant's arguments filed 7 August 2007 have been fully considered but they are not persuasive. Please see rejection grounds above.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas A. Smith whose telephone number is (571)-272-8760. The examiner can normally be reached on 8:30 AM to 5:00 PM, Monday through Friday.

13. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Susy Tsang-Foster can be reached on (571)-272-1293. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Harry D. Wilkins, III/
Harry D. Wilkins, III
Primary Examiner
Art Unit 1795

NAS